

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Ian Zenoni	Examiner: John Schnurr
Serial No.:	10/728,572	Group Art Unit: 2421
Filed:	December 5, 2003	Docket: 2050.100US1
Customer No.	44367	Confirmation No.: 8936
Title:	Application streamer	

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Applicant requests review of a response to the *Final Office Action (Office Action)*, dated September 10, 2009, and a resulting *Advisory Action*, dated January 6, 2010. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for at least the reasons stated below.

**Rejection of the Claims under 35 U.S.C. §103(a)**

On page 2, paragraph 3 of the *Office Action*, the Examiner rejected claims 1-6, 9-14, and 17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Published Patent Application No. 2004/0049790 to Russ et al. (*Russ*), in view of U.S. Published Patent Application No. 2002/0199190 to *Su*, and further in view of U.S. Published Patent Application No. 2001/0000194 to *Sequeira*. Since a *prima facie* case of obviousness has not been properly established, Applicant respectfully traverses the rejection.

The recent U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

The rationale to support a conclusion that a claim would have been obvious is that **all the claimed elements were known in the prior art** and one skilled in the art could have combined the elements as claimed by known methods **with no change in their respective functions**, and **the combination would have yielded nothing more than predictable results** to one of ordinary skill in the art.<sup>1</sup>

Applicant will show that the cited references, either singly or in combination, neither teach nor suggest all limitations of Applicant's claimed elements, with no change in the respective functions of the cited references; nor is there any substantiating evidence that the combination of the references would have yielded nothing more than predictable results. "If **any of these [three] findings** cannot be made, then this rationale [of combining prior art elements according to

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<sup>1</sup> See *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); see also MPEP § 2143, emphasis added.

known methods to yield predictable results] cannot be used to support a conclusion that the claim would have been obvious.”<sup>2</sup>

In particular, Applicant’s independent claim 1 recites, *inter alia*,

[U]sing said application streamer to create a file directory structure based on a priority for each file in the file directory structure, the priority for each file determined using information ***about each file present in said textual data and said file directory structure comprising at least one data file and at least one graphical data file formatted by the application streamer to be compatible with the set-top box;***

using said application streamer to create a node tree on a broadcast streamer by mirroring said file directory structure such that each file in said file directory structure becomes a node ***with a corresponding priority in said node tree*** on said broadcast streamer;

***allocating bandwidth and transmission frequency*** to each node of said node tree based ***on the corresponding priority*** of each said node; and

using said broadcast streamer to multiplex said nodes of said node tree with a regular broadcast stream resulting ***in an interactive data stream.***<sup>3</sup>

Applicant’s other independent claim, claim 9, shares similar types of limitations with claim 1.

In the *Advisory Action*, the Examiner stated, “In response to applicant’s arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.”<sup>4</sup> However, Applicant asserts that where, as here, ***the Examiner relied exclusively on a particular single reference*** to allegedly teach or suggest one or more specific claimed elements, then that reference can only be refuted by attacking the reference individually.

The Examiner relied exclusively on *Sequeira* to “disclose[] a system for broadcasting carousel data, [that] clearly teaches storing an indication of file priority with the file in the directory structure, the priority determined using information about the file ([0087]).”<sup>5</sup> Although *Sequeira* does discuss that, “data in QueueSlot Field 2013 allows the data carousel to assign different priority levels to different assets,”<sup>6</sup> the Examiner has failed to consider Applicant’s entire claimed element. Specifically, Applicant’s claim element recites, *inter alia*,

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<sup>2</sup> MPEP § 2143, emphasis added.

<sup>3</sup> Emphasis added.

<sup>4</sup> *Advisory Action* at 2.

<sup>5</sup> *Office Action* at 3.

<sup>6</sup> *Sequeira* at paragraph [0087].

“the priority for each file determined using information *about each file present in said textual data and said file directory structure comprising at least one data file and at least one graphical data file formatted by the application streamer to be compatible with the set-top box.*”<sup>7</sup> *Sequeira*, at best, merely discusses assigning different priority levels to different assets, nothing more. *Sequeira* therefore fails to discuss Applicant’s entire claimed element in the context of at least one graphical data file formatted by the application streamer to be compatible with the set-top box. Indeed, *Sequeira* is entirely silent on point and the Examiner has failed to show any other reference or combination of references disclosing this element.

Moreover, the Examiner relied exclusively on *Russ* to teach or suggest Applicant’s claimed element of “using said application streamer to create a node tree on a broadcast streamer by mirroring said file directory structure such that each file in said file directory structure becomes a node with a corresponding priority in said node tree on said broadcast streamer.”<sup>8</sup> Specifically, the Examiner stated that, “Each of the files in the file system [is] assigned a position for broadcast, [0031]-[0032]. The BCS server 106 broadcasts higher priority files more frequently, [0033].”<sup>9</sup> However, in contrast to the Examiner’s assertion, *Russ* merely discusses repeatedly broadcasting blocks based on a selection from a remote DHCT. However, the blocks are not broadcast according to any priority.

*The remote DHCT 600 selects a file* (block 406) from the directory index and communicates its selection to the gateway device 500. *The BCS server 106 and/or the content servers repeatedly broadcast (block 407) the selected file, among other files*, to the gateway device 500. The BCS server 106 may broadcast files using any of a number of possible broadcasting schemes. As a non-limiting example, among others, one scheme may involve broadcasting certain files more frequently than other files.<sup>10</sup>

Thus *Russ* simply discusses broadcasting both selected files, among other files, repeatedly. *Russ* is completely silent on broadcasting files based on “*a corresponding priority* in said node tree on said broadcast streamer” as recited in Applicant’s claim 1.

The Examiner further relied on *Russ* to disclose Applicant’s claimed element of “allocating bandwidth and transmission frequency to each node of said node tree based on the

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<sup>7</sup> Emphasis added.

<sup>8</sup> *Office Action* at 3.

<sup>9</sup> *Ibid.*

<sup>10</sup> *Russ* at paragraph [0033].

corresponding priority of each said node.” Specifically, in support of this assertion, the Examiner simply stated that, “The BCS server 106 broadcasts certain files more frequently, [0033].”<sup>11</sup> However, as noted above, *Russ* merely discusses broadcasting both selected files, among other files, repeatedly. Applicant can find no teaching or suggestion anywhere within *Russ* of **allocating bandwidth and transmission frequency** to each node of said node tree **based on the corresponding priority** as claimed. *Russ* simply has no discussion whatsoever on allocating bandwidth and transmission frequency, much less performing the allocation based on a corresponding priority.

Additionally, the Examiner further relied on *Russ* to teach or suggest Applicant’s claimed element of “using said broadcast streamer to multiplex said nodes . . . resulting **in an interactive data stream.**” Other than a mere program guide, which certainly cannot be considered interactive content, Applicant is unable to find any reference within *Russ* to an interactive data stream. Once again, *Russ* is entirely silent on point. Indeed, many of the Examiner’s statements that the cited reference teaches or suggests the Applicants’ claimed elements are merely conclusory with no actual support found in *Russ*. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”<sup>12</sup> Although the Examiner referred to portions of *Russ*, there is no rational argument providing a legal nexus between the referenced portions and Applicant’s claims.

Moreover, Applicant notes with interest that the Examiner used three references in the rejection of independent claims 1 and 9. The number of references is highly suggestive that the Examiner is using Applicant’s structure as a template and selecting individual elements from each reference in a hindsight reconstruction of Applicant’s claimed invention. Further, the use of individual elements from the references suggests that the Examiner is merely considering whether the differences are obvious, not whether the invention as a whole is obvious. The U.S. Supreme Court has held that **USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation.** Instead, the claim as a whole must be considered.<sup>13</sup> When considered as a whole, Applicant’s claimed elements are neither taught nor suggested by any combination of the cited references.

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<sup>11</sup> *Office Action* at 3.

<sup>12</sup> *See In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41 (2007))

<sup>13</sup> *See, e.g., Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981).

Since Applicants have shown that not all the claimed elements were known as required by *KSR*, either by *Russ* singly or in combination with *Su* or *Sequeira*, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §103 with regard to independent claims 1 and 9. Since claims 2-6, 10-14, and 17 depend, either directly or indirectly, from claims 1 or 9, they too are allowable for at least the same reasons as the claims from which they depend. Further, each of these dependent claims may be patentable for its own limitations.

On page 5, paragraph 5 of the *Office Action*, the Examiner rejected claims 7, 8, 15, and 16 under 35 U.S.C. §103(a) as being unpatentable over *Russ* in view of *Su* in view of *Sequeira*, as applied to claim 6 above, and further in view of U.S. Patent No. 6,618,353 to Standridge et al. (*Standridge*). However, these claims depend from claims 1 or 9 that Applicant has shown to be allowable. The cited reference to *Standridge* fails to supply the elements of the independent claims 1 and 9 that were shown above to be missing from any combination of *Russ*, *Su*, or *Sequeira*. Therefore, claims 7, 8, 15, and 16 are also allowable for at least the same reasons as the claims from which they depend. Further, each of these dependent claims may be patentable for its own limitations.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 660-2015 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402--0938  
(408) 660-2015

Date 11 January 2010

By



Bradley W. Schoer  
Reg. No. 47,059

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 11 day of January, 2010.

John D. Gustav-Wrathall  
Name

  
Signature